



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/553,488

08/09/2006

Steven Weber

ESSR:098US/10510809

1295

32425 7590 05/04/2010
FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

EXAMINER

PEZZUTO, HELEN LEE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,488	Applicant(s) WEBER ET AL.	
	Examiner Helen L. Pezzuto	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-74,76-79,81-95,97-101 and 103-131 is/are pending in the application.
- 4a) Of the above claim(s) 83-95,97-101 and 103-127 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-74,76-79,81,82 and 128-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 64-74,76-79,81-95,97-101 and 103-131 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claim 83-95, 97-101, 103-127 drawn to an invention nonelected with traverse in the reply filed on 8/5/09. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Claims 83-95, 97-101, 103-127 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/5/09.

Response to Amendment

Applicant's amendment to claims 64-69, 81, 83-88, 97, 103, 118-123, 126, the cancellation of claims 75, 80, 96, 102, and the addition of claims 128-131 filed in the response on 3/9/10 is acknowledged. In light of applicant's amendment and remarks, Fukushima et al. (US-550) is withdrawn as an applied reference because it does not expressively disclose a non-aromatic mono or diacrylate monomer or oligomer. Jiang et al. (US-606), Keita et al. (US-831), and Oshikiri et al. (US-953) are withdrawn as applied references because their compositions contain essential elements which are excluded in the amended claims.

Art Unit: 1796

Currently, claims 64-74, 76-79, 81-82, and 128-131 are under consideration.

Claim Objections

3. Claims 66, 68-73 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. There is a lack of antecedent basis for the recited "polyacrylate" monomer in the amended claim 64.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 64-74, 76-79, 81-82, and 128-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (US-323).

US 6,184,323 B1 to Jiang discloses and exemplifies a photopolymerizable composition comprising 10-70 wt% of a difunctional thio(meth)acrylate as set forth in formula (I), 10-60 wt% of at least one monomer as set forth in formula (III), 5-30 wt% of at least one aromatic or polycyclane mono(meth)acrylate as set forth in formula (IV), up to 15 wt% of a polyalkylene glycol di(meth)acrylate, which fall within the scope of the recited polymerizable monomer/oligomer (B), (C), (A), and (D) respectively (see abstract; col. 2, line 50 to col. 4, line 67; working examples). Specifically, suitable polycyclane mono(meth)acrylate and polyalkylene glycol di(meth)acrylate species are disclosed within the scope of the instant mono or diacrylate or oligomer (A), and the aromatic mono(meth)acrylate as set forth in Formula (IV) falls within the scope of the instant (D) (col. 4, lines 45-66; col. 5, lines 1-37). Furthermore, prior art teaches incorporating 0.001 to 5 wt% of a photoinitiator (col. 6, lines 44-56; working Examples, Table 1). The resultant compositions have refractive index within the range expressed in claim 82 (cols. 7-8, Table 1). US-323 discloses the presently claimed composition within the recited proportions. The reference is silent regarding the solubility parameter of monomer (A) as expressed in claims 70-71. The examiner is of the position that once the selection of

Art Unit: 1796

suitable monomer (A) species is selected and utilized, the recited solubility property would be an inherent characteristic in prior art monomer (A), because such properties would necessarily flow from the teaching of the applied prior art. It is a reasonable presumption that the characteristics of the same or obvious chemical entities would be the same. Accordingly, it would have been obvious to one having ordinary skill in the art to select and employ a mixture of the recited (A)-(D) monomers in the preparation of the various optical polymer systems as taught in the prior art disclosure, motivated by the reasonable expectation of success of producing ophthalmic lens with enhanced properties.

Response to Arguments

Applicant's amendment and remarks filed on 3/9/10 have been fully considered. Applicant urges that the newly recited "consisting of" as well as the proviso language in the amended claim 64 would exclude prior art TBr BA or TBr EBA. The examiner respectfully disagrees because they are not expressively taught to be essential ingredients in prior art composition. Furthermore, contrary to applicant's assertion, they are not employed in all the working Examples. Accordingly, the examiner is of the position that since prior art combination meets the terms of the present claims, the instant invention is deemed to

Art Unit: 1796

be within the sphere of obviousness encompassed by the disclosure of the reference as set forth in the preceding paragraph.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796

hlp